

U.S. Serial No. 09/732,241  
Attorney Docket No. P-095-US1  
Page 2

### REMARKS

Applicants respectfully request that this application be reconsidered in view of the following remarks.

1. Status of the Claims

Claims 1-52 are currently pending in this application for examination on the merits. Claims 1-52 stand rejected for the reasons of record set forth in the Office Action dated May 30, 2002. In the present Office Action, the Examiner has not discussed Applicants' response to the prior Office Action in any way, but has instead further imposed an election of species requirement.

2. Election of Species Requirement Under 35 U.S.C §121

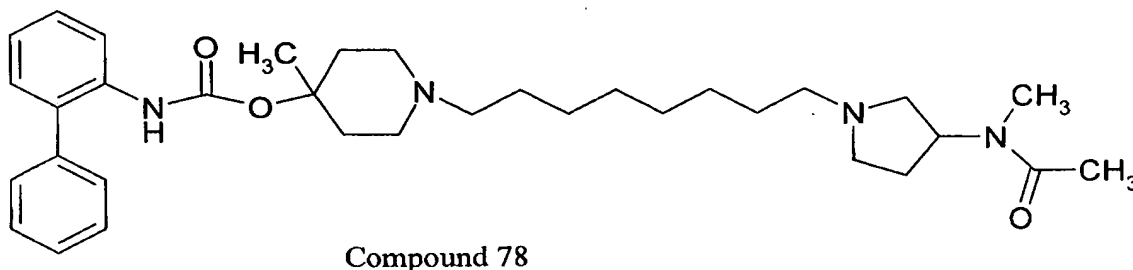
The Examiner has indicated that Claims 1 to 20 are generic to a plurality of disclosed patentably distinct species and as a result, Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is held to be allowable. For the following reasons, this election of species requirement is respectfully traversed.

An election of species requirement is improper if examination of all the species does not create a serious burden on the Examiner. In the present case, the Examiner has already issued two Office Actions (dated October 10, 2001 and May 30, 2002) in which all the claims were examined on the merits. Since the Examiner presumably conducted a proper search before issuing the two previous Office Actions on the merits, no serious burden should now be imposed on the Examiner that would require an election of species. Accordingly, since no serious burden exists, Applicants respectfully suggest that the present election of species requirement is improper and should be withdrawn.

In order to comply with 35 U.S.C. §121, Applicants are required to elect a single disclosed species for prosecution on the merits. In response, Applicants elect (with traverse for the reasons stated above) Compound 78, which is disclosed in Table B on page 106 of Applicants' specification, in which compound ring A is a phenyl ring; ring B is a piperidine

U.S. Serial No. 09/732,241  
Attorney Docket No. P-095-US1  
Page 3

ring; and R<sup>2</sup> is a phenyl ring. Specifically, Compound 78 has the formula:



Claims 1, 2, 3, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 32, 34, 35, 36, 37, 43, 46 read on the elected species. Additionally, the pharmaceutical composition of Claim 47 and the methods of Claims 48 and 49 are readable on the elected species.

If the Examiner decides to maintain the election of species requirement, Applicants respectfully request that the Examiner provide a complete action on the merits of all claims readable on the elected species pursuant to the guidelines of MPEP §809.02(c). In this regard, Applicants further note that the guidelines of MPEP §803.02 require that if no prior art is found that anticipates or renders obvious the elected species, the search and examination should to be extended to include additional species. Moreover, if a generic claim is found allowable, Applicants respectfully request consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of the allowed generic claim as provided by 37 C.F.R. §1.141.

Additionally, Applicants note that the Examiner has indicated:

Upon election, the Examiner will review the claims and indicate (a) a generic concept inclusive of the elected species {compounds which are so similar thereto as to be part of the elected matter} and (b) by such indication (i.e. by exclusion) which compounds are drawn to non-elected subject matter. Office Action at page 3.

U.S. Serial No. 09/732,241  
Attorney Docket No. P-095-US1  
Page 4

In response, Applicant respectfully request clarification on which rule or regulation allows the Examiner to give, in effect, a *post-facto* restriction requirement based on an election of species. In this regard, Applicants respectfully request that in the interest of fairness, if a restriction requirement is to be imposed on the pending claims, the Examiner should set forth, in advance, the groups forming the basis for the restriction requirement and which claims are in each group as described in MPEP §817. By doing so, Applicants will have an opportunity to adequately respond to the restriction requirement. Moreover, if the Examiner intends to define inventions within individual claims, Applicants respectfully bring to the Examiner's attention that it is clearly established that the USPTO cannot require an applicant, under the guise of §121, to divide up the embodiments of a single Markush claim. Specifically, the Court of Customs and Patent Appeals has clearly stated:

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *In re Weber*, 198 USPQ 328, 331 (CCPA 1978) (emphasis in original).

In this regard, the Examiner's attention is further directed to MPEP §803.02.

Accordingly, Applicants respectfully request that a proper restriction requirement be issued if the Examiner believes this application contains independent and distinct inventions. If not, Applicants respectfully request a complete action on the merits of all claims readable on the elected species pursuant to the guidelines of MPEP §809.02(c).

For the foregoing reasons and for the reasons of record in Applicants' prior response dated August 22, 2002, Applicants believe that this application is in condition for allowance

U.S. Serial No. 09/732,241  
Attorney Docket No. P-095-US1  
Page 5

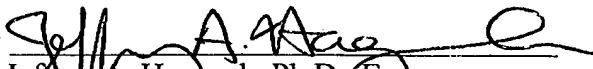
and a notice to that effect is respectfully requested. Should there be any remaining issues that can be resolved by telephone, the Examiner is respectfully requested to telephone the undersigned attorney at (650) 808-6406.

Respectfully submitted,

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